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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91161817
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UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

NEXTEL COMMUNICATIONS, INC.,)	
)	
Opposer,)	
)	Opp. No.: 91/161,817
v.)	App. No.: 78/235,618
)	Mark: Sensory Mark
MOTOROLA, INC.,)	(911 Hz tone)
)	
Applicant.)	
)	

APPLICANT'S REPLY MEMORANDUM IN SUPPORT
OF ITS MOTION FOR SUMMARY JUDGMENT

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I. SUMMARY

Motorola's Sound Mark: (1) is used as a mark on Motorola's two-way radios; (2) is inherently distinctive; and (3) in the alternative, has acquired distinctiveness. Motorola's Sound Mark is therefore entitled to registration. Nextel's assertions to the contrary are entirely unsupported by any evidence of record. Because Nextel has not met its burden of proof on the allegations in its Notice of Opposition, summary judgment should be entered in favor of Motorola.

II. MOTOROLA HAS USED ITS SOUND AS A MARK, AND NEXTEL HAS NO EVIDENCE ESTABLISHING OTHERWISE

A. Nextel's Professed Internal Unawareness Does Not Establish Non-Use

According to Nextel, no one within Nextel has ever "reported being aware of or having seen or heard any advertisement or other instance of use of the 911 Hz Tone that would constitute trademark use." (Nextel's Opposition Brief at 5.) The issue raised by Nextel's allegation of non-use, however, is far broader than Nextel's awareness. To prevail on its claim, Nextel must establish that Motorola has never commercially used the Sound as a mark in connection with two-way radios. Nextel's internal unawareness, even if true, is far too limited and legally insufficient to meet Nextel's burden of proof.

B. Motorola's Application Includes Evidence Of Motorola's Use, And Whether Motorola Advertises The Sound Mark In Connection With Its Two-Way Radios Is Irrelevant

Nextel argues that, "No advertising use or any other use of the Tone as a mark is evident on the face of the application or apparent from the specimen." (Nextel's Opposition Brief at 5.) But there is no dispute that the specimen submitted with Motorola's application contains the

Sound Mark at issue. Moreover, there is no dispute that Motorola's trademark application includes a declaration wherein Motorola states that, "The applicant is using the mark in commerce ... on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended." (Ex. 7.)¹

In addition, Motorola has extensively promoted the product from which the Sound Mark emanates. Motorola is not required to advertise the Sound Mark separately. The law is well-settled that advertising is not trademark use in connection with goods. *See* T.M.E.P. § 904.05. So if Motorola had submitted advertising as evidence of use in its application, the advertising would have been rejected by the Examining Attorney. *See id.* Use of the Sound Mark in connection with two-way radios – such as an audible tone emanating from the two-way radios themselves – is *trademark* use. *See* T.M.E.P. § 1202.15. Nextel's argument to the contrary ignores the fact that Motorola's application covers two-way radios, which are goods, not services.

C. The Fact That Motorola's Sound Has A Dual Purpose Does Not Disqualify The Sound From Being A Mark

Nextel cites to deposition testimony of Motorola's 30(b)(6) designee, Mr. David Klein, who testified that Motorola's Sound Mark alerts two-way radio users that a channel is available for use. This fact, Nextel argues, disqualifies the Sound from being a trademark. Nextel relies heavily on this argument throughout its Brief. (Nextel's Opposition Brief at 6-8 and 10-13.) Nextel's argument is legally incorrect.

¹ All Exhibits referred to in this Reply Memorandum are attached to Motorola's Opening Memorandum.

1. Motorola's Sound Mark Is A Dual Purpose Trademark

Motorola agrees that *a* purpose of the Sound Mark is to alert users to an operation of the radios. But the Sound Mark simultaneously operates as a source identifier. The two purposes can, and do, co-exist. To ignore this is to ignore the trademark character of the Sound Mark and the “meaning” it carries under *Qualitex Co. v. Jacobson Products Co.*, 34 U.S.P.Q.2d 1161 (1995).

The Board has recognized the concept of dual purpose trademarks in other contexts. *See, e.g., In re Paramount Pictures Corp.*, 217 U.S.P.Q. 292 (T.T.A.B. 1983), where the Board stated, “Obviously, the Lanham Act does not exclude registration of a mark simply because it has an ornamental as well as a source indicating purpose.” *Id.* at 293. In reversing the Examiner’s refusal of a mark used for the dual purpose of ornamentation as well as a source indicator, the Board explained:

Thus, in each situation involving a different type of affixation, the key question is . . . “Does the subject matter perform a trademark function when used in this manner?” Stated another way, “Would a purchaser recognize this mark as indicating the source of these goods?” *Id.*

Motorola’s uncontroverted evidence establishes that consumers do, in fact, recognize Motorola’s Sound Mark as identifying a “single, albeit anonymous, source” of the two-way radios – if not Motorola itself. *See Paramount*, 217 U.S.P.Q. at 294 (citing *Johnson & Johnson v. E. I. du Pont de Nemours & Co.*, 181 U.S.P.Q. 790 (T.T.A.B. 1974)).

The fundamental flaw with Nextel’s argument is that it overlooks the Patent and Trademark Office’s acknowledgment that “dual use” trademarks are registerable. *See, e.g., In re Paramount*, 217 U.S.P.Q. at 293; *In re Watkins Glen Int’l, Inc.*, 227 U.S.P.Q. 727, 729 (T.T.A.B. 1985) (“ornamental matter which may additionally perform a source-indicating function is registrable if it is found to be a trademark of applicant”); *In re Paramount Pictures Corp.*, 213

U.S.P.Q. 1111, 1113 (T.T.A.B. 1982) (holding that a mark may be both ornamental and source-indicating). As the Board explained in *Paramount*:

In the case of musical sound, for example, the entertainment aspect generally overwhelms any other. However, this is not always the case and where a particular musical sound has, or also has, source indicating significance, we have recognized this trademark function by issuing a registration of the sound as a mark. *Paramount*, 213 U.S.P.Q. at 1113.

Thus, a sound may serve more than one purpose and so long as one of its purposes is to identify source, the sound is a mark.

Although Nextel cites Mr. Klein's deposition testimony that the Sound Mark signals the availability of an audio channel, Nextel fails to mention his testimony regarding the trademark function of the Sound, which entitles the Sound Mark to registration:

The 911 Hz Tone signifies the microphone—either the channels available for communication or that the microphone is active and transmitting. So it allows the user to understand that. *In addition, they know that when they hear that tone, that tone is coming from a Motorola product.* (Ex. 2, Klein Dep. at 44-45, emphasis added.)

This is no different from the dual purposes served by the shape of the Coca-Cola bottle: to contain the soda and to identify its source.

2. Motorola's Sound Mark Is Not Functional

Although Nextel argues that the Sound Mark is functional because it serves a purpose, Nextel has submitted no evidence establishing that the Mark is "functional" as the term is applied by the Supreme Court. Specifically, Nextel submits no evidence that the Sound is "essential to the use or purpose of the [radio]." See *Qualitex*, 34 U.S.P.Q.2d at 1163-64. There is an almost limitless number of sounds available, none of which carries any advantage over any other. Nextel likewise offers no evidence that the Sound "affects the cost or quality of the [radio]." See *Id.* As a result of Nextel's inability to offer any evidence on these issues, Nextel has failed to establish that registration of the Sound Mark "would put competitors at a significant

non-reputation related disadvantage.” *See Id.* at 1164. This destroys Nextel’s functionality argument.

III. MOTOROLA’S SOUND MARK IS DISTINCTIVE, AND NEXTEL HAS NO EVIDENCE ESTABLISHING OTHERWISE

Nextel’s attack on the alleged lack of distinctiveness of Motorola’s Sound Mark must be evaluated against *Qualitex Co. v. Jacobson Products*, 34 U.S.P.Q.2d 1161 (1995), the seminal case regarding nontraditional marks. There, the Supreme Court rejected a blanket prohibition against registration of a color as a trademark. *See id.* at 1167. In doing so, the Court noted that there is no “special legal rule” against trademark registration for a color. *See id.* The Court’s reasoning was based, in part, upon Lanham Act legislative history indicating that the words “symbol or device” in the statute do not preclude “the registration of colors, shapes, sounds or configurations where they function as trademarks.” *See id.* at 1166-67 (citations omitted).

Motorola’s Sound Mark meets each of the two standards for distinctiveness set forth in *In re General Electric Broadcasting Co., Inc.*, 199 U.S.P.Q. 560 (T.T.A.B. 1978):

[A] distinction must be made between [1] unique, different, or distinctive sounds and [2] those that resemble or imitate “commonplace” sounds or those to which listeners have been exposed under different circumstances. This does not mean that sounds that fall within the latter group, when applied outside of the common environment, cannot function as marks for the services in connection with which they are used. But, whereas the arbitrary, unique or distinctive marks are registrable as such on the Principal Register without supportive evidence, those that fall within the second category must be supported by evidence to show that purchasers, prospective purchasers and listeners do recognize and associate the sound with services offered and/or rendered exclusively with a single, albeit anonymous, source. *Id.* at 563 (bracketed numbers added).

A. Motorola’s Sound Mark Is Unique, Different, And Distinctive

Motorola’s Sound Mark is unique, different, and distinctive, with a particular tone, cadence, and texture coined by Motorola. The Examiner acknowledged this inherent

distinctiveness by approving the Sound Mark for publication without a showing of acquired distinctiveness under Section 2(f).

Nextel continues to offer no evidence whatsoever as to where, how, when, or by whom the Sound – or anything similar to the Sound Mark – has ever been used in connection with two-way radios or any other products. Despite its enormous resources, Nextel has been unable to produce any evidence of a single sound that might demonstrate that Motorola’s Sound Mark is not unique, different, or distinctive.

B. In the Alternative, Motorola’s Sound Mark Has Acquired Distinctiveness

Motorola’s Sound Mark is not a commonplace sound, nor is it a sound to which listeners have been exposed under different circumstances. Indeed, Nextel makes no attempt at all to adduce evidence to the contrary.

Instead, Nextel argues that Motorola’s Sound Mark cannot be distinctive because “*consumers expect* that electronic devices, such as two-way radios and cell phones, contain a number of different electronic signal tones to alert them to the activation of different functions or events.” (Nextel’s Opposition Brief at 9, emphasis added.) Nextel is unable to support its statement of consumer expectation with any evidence, so it instead cites to pages 14-16 of its pending motion for summary judgment. Referring to the cited pages of that motion – and in particular to the last complete paragraph on page 15 – shows no record support, which exposes the bankruptcy of Nextel’s assertion as to what consumers expect. Nextel cannot establish consumer expectation by merely declaring it to be a certain way. There is no triable issue here.

On the other hand, Motorola has adduced uncontradicted evidence showing that the relevant public recognizes and associates the Sound Mark with a single, albeit anonymous, source. (*See* Motorola’s Opening Memorandum at 2-4 and 14-15.) Motorola’s evidence of acquired distinctiveness is in the well-established form of a consumer survey, length of use, and

extensive sales and advertising. *See, e.g., In re Owens-Corning Fiberglas Corp.*, 227 U.S.P.Q.2d 417, 422-24 (Fed. Cir. 1985); *In re Instant Transactions Corp. of Am.*, 201 U.S.P.Q. 957, 958 (T.T.A.B. 1979); T.M.E.P. § 1212.06(a)-(d).

Although Nextel argues that the survey run by RL Associates is flawed, this is mere attorney argument. Nextel offers no survey, pilot study, pre-test or any other empirical evidence of its own on whether the Sound Mark has acquired distinctiveness. Nor has Nextel presented any testimony from any witness, expert or otherwise, that challenges, contradicts, or even questions the results of the RL Associates survey. In other words, Nextel has *no evidence whatsoever* in response to the survey run by RL Associates.

Nextel therefore resorts to mere partisan argument, which does not discredit the RL Associates survey. *See Martahus v. Video Duplication Servs., Inc.*, 27 U.S.P.Q.2d 1846, 1849 (Fed. Cir. 1993) (“mere attorney arguments unsubstantiated by record evidence are suspect at best”).

In any event, Nextel’s attorneys’ argument is baseless. At the beginning of each interview, respondents heard Motorola’s Sound Mark and were then asked, “Please tell me what it is and what, if anything, you know about this sound.” (Ex. 12, Rappeport Report at MOT 004681.) Fifty two percent (52%) of respondents identified the sound as coming from a two-way radio and/or a walkie-talkie. (Ex. 12, Rappeport Report at MOT 004684.) Those respondents were then asked whether one company or more than one company makes the radio and/or walkie-talkie. The respondents had already identified and tied the Sound Mark to a two-way radio and/or walkie-talkie. The only remaining question was whether the radio and/or walkie-talkie they were thinking of, and had already identified, was made by one source or more than

one source. Forty-two percent (42%) identified a single source. This is a direct measure of acquired distinctiveness.

Nextel's attorneys also argue that only those respondents who specifically identified Motorola as the source of the radios and/or walkie-talkies qualify as evidence of acquired distinctiveness. (Nextel's Opposition Brief at 14.) This argument apparently means that it is not enough for respondents to associate the Sound Mark with a single source, they must also identify it with the *correct* source. Nextel is flatly wrong on this point. *See Tone Bros. v. Sysco Corp.*, 31 U.S.P.Q.2d 1321, 1329-30 (Fed. Cir. 1984) (reversing entry of summary judgment where district court failed to credit survey offered by trademark owner showing 37% respondents identified the mark with a single source, even though more respondents identified an incorrect source than identified the trademark owner).

Nextel claims that Motorola cannot rely on *Textron, Inc. v. Int'l Trade Comm'n*, 224 U.S.P.Q. 625 (Fed. Cir. 1985), for the proposition that "40% and 37% respondent recognition levels have been held to be sufficient to establish acquired distinctiveness." (Motorola's Opening Memorandum at 16.) The passage from the Federal Circuit's *Textron* decision that directly supports this proposition, by citation to Board cases, is set forth below:

These results [of the survey run in *Textron*] compare favorably with results achieved in a number of cases which have found secondary meaning for the products in question, largely on the basis of survey evidence. *See, e.g., Ideal Toy Corp. v. Plawner Toy Mfg. Corp.*, 685 F.2d 78, 82, 216 U.S.P.Q. 102, 106 (3d Cir. 1982) (40 percent recognition); *Monsieur Henri Wines v. Duran*, 204 U.S.P.Q. 601, 605 (TTAB 1979) (37 percent recognition). *Textron*, 224 U.S.P.Q. at 628.

Nextel also claims that the *Textron* survey showed a secondary meaning level of 61%. Nextel fails, however, to account for the 15-16% of "noise" established by the controls in the survey. Taking the noise into account, the secondary meaning level in *Textron* was 45-46%, which is very close to the 42% found by the unchallenged survey run by RL Associates.

IV. MOTOROLA IS NOT PRESENTLY SEEKING A “PRECLUSION SANCTION”

Recognizing that it has failed to adduce any evidence in support of its allegations, Nextel argues that Motorola’s motion should be denied because this is not a case where a “preclusion sanction” is warranted. (Nextel’s Opposition Brief at 3.) Motorola, however, is not presently seeking a preclusion sanction. Indeed, such a sanction is not needed for entry of summary judgment in favor of Motorola. The case on which Nextel relies shows why.

In *Vignette Corporation v. Steven Marino*, Opp. No. 91/155,854 (TTAB Nov. 29, 2005), the applicant opposed the opposer’s motion for summary judgment by submitting a declaration where for the first time, he attested to certain facts supporting his *bona fide* intention to use the mark at issue in commerce. (*Id.* at 4.) The opposer moved to strike the declaration because it introduced into the record facts that opposer had requested in discovery, but that applicant had not previously produced. The Board denied the motion to strike because the applicant had merely failed to supplement his discovery responses.

In the case before the Board, however, Nextel has *never* come forward with any facts to support its allegations. Thus, whereas the non-movant in *Vignette* eventually came forward with supporting facts, Nextel has at all times been unable to come forward with any facts to support its allegations. *Vignette* is inapplicable.

(continued next page)


V. CONCLUSION

For the foregoing reasons, Motorola respectfully requests that summary judgment be entered against Nextel and that Motorola's Application Serial No. 78/235,618, issue to registration in due course.

Respectfully submitted,

Dated: January 5, 2006

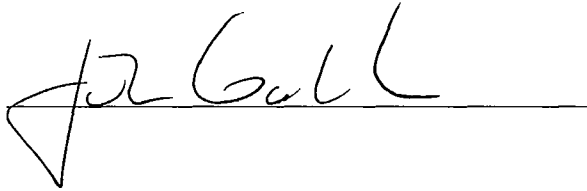
MOTOROLA, INC.

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of APPLICANT'S REPLY MEMORANDUM IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT was served on counsel for Opposer on January 5, 2006, via email and First Class Mail, postage prepaid:

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A handwritten signature in black ink, appearing to read "Michael H. Jacobs", is written over a horizontal line. The signature is stylized, with the first name "Michael" written in a cursive-like script and the last name "Jacobs" in a more formal, blocky script.